

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 50-52, 54-58 and 67 are pending in this application. Independent claim 67 has been amended to include the limitation “wherein the outermost layer is a metal oxide layer”. This claim amendment finds support in specification, e.g. in Figures 6, 7, 8, and 10, as well as page 14, lines 6-10 and page 7, lines 15-17. Claims 50-52 and 54-58 have not been amended. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

A. Claim 67 was rejected as allegedly being obvious over Miyoshi et al. (U.S. Patent 5,968,531 - “Miyoshi”) in view of Kimura et al. (U.S. Patent 5,522,923 - “Kimura”). The applicants request reconsideration for the following reasons.

Claim 67 was previously rejected over Miyoshi alone and the applicants argued that several of the elements of the applicants’ invention were not taught by Miyoshi. In response, the rejection over Miyoshi was supplemented by the use of Kimura. However, the combination of references do not teach or suggest all of the limitations for the claims as amended.

In addition, establishing a *prima facie* case of obviousness requires more than merely accumulating elements of the applicants’ claimed invention in one or more references.¹ After

¹ “It is well known that ‘virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)(citations omitted). ”

making the as a whole determination of the applicants' invention and the cited references (*see* MPEP 2141, section II), there must be some reason for making the requisite combination whether explicitly stated in the references or some well-known rationale to those of ordinary skill in the art.

Furthermore, there must be a reasonably likelihood of success for the proposed combination (MPEP 2143.02) and the proposed modification cannot render the reference unsatisfactory for its intended purpose (MPEP 2143.01)

Miyoshi refers to a substrate particles for protection against UV-rays that may be made of mica, the particle having a plurality of smaller particles of TiO₂ attached to its surface whereas Kimura refers to a **red pigment** consisting of flat particles (which may be mica particles) with an iron oxide layer of 60-350 nm, and an aluminum-based layer **outside** of the iron oxide layer of 150-500 nm. However, both these references lack a teaching that the outermost layer of the respective particles have an outermost layer which is Fe₂O₃ or a mixture of Fe₂O₃/TiO₂.

It is well-known that it is improper to simply "pick and choose" from within a reference to the exclusion of the requisite as a whole consideration of the cited reference.² One of ordinary skill in the art of making compositions intended for UV-protection with the intention of improving the composition according to the methods of Miyoshi had no reason to study the document according to Kimura having the object of improving the color tone of pigments. Whatever reason exists for combining Miyoshi and Kimura does not come from the teachings themselves nor does it flow from what was known by the those of ordinary skill in the art at the time the invention was made.

Furthermore, the pigments according to Miyoshi consists of particles having smaller particles of TiO₂ attached to it and the skilled artisan would not seek to improve his invention by searching for alternative pigments consisting of completely different types of particles, i.e. particles with a coating, instead of a plurality of attached small particles such as disclosed in Kimura. Such a procedure would require an undue amount of experimentation and changes to subsequent production procedures for the particles, i.e. there is no suggestion for the likelihood of success for making such a combination. However, even if it was possible to combine Miyoshi

² It has previously been held that "[i]t is impermissible within the framework of section 103 to **pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

and Kimura, the skilled artisan would not end up with the composition as claimed, but rather with a composition having particles with an ***outermost layer of aluminum*** and such a particle would not reduce UV-rays to a great extent, i.e. would render the Miyoshi reference to be unsuitable for its intended purpose.

Therefore, for any of the reasons cited above, the combination of Miyoshi and Kimura does not establish a holding of *prima facie* obviousness of the applicants' claims.

B. Claim 56 was rejected as allegedly being obvious over Miyoshi et al. (U.S. Patent 5,968,531 - "Miyoshi") in view of Kimura et al. (U.S. Patent 5,522,923 - "Kimura") and further in view of Haning et al. (U.S. Patent 6,042,619 - "Haning").

Claim 56 is dependent upon claim 67 as the comments provided above also apply here. In addition, the use of Haning is also in the category of improper picking and choosing, i.e. there is no reason to select the particular element of pearlescent appearance for combination with Miyoshi and Kimura when making the as a whole analysis of Haning (i.e. the optional pearlescent ingredients are for the combination of directed to ***quaternary amine polymers*** with a metal containing pigment; none of Miyoshi or Kimura use a quaternary amine polymer in their product).

C. Claims 50-52, 54, 55, 57, 58 and 67 were rejected as allegedly being obvious over Ogawa et al. (EP 0 998 901 - "Ogawa") in view of Kimura et al. (U.S. Patent 5,522,923 - "Kimura").

Claims 50-52, 54, 55, 57, 58 and 67 were rejected as allegedly being obvious over Ogawa et al. (EP 0 998 901 - "Ogawa") in view of Kimura et al. (U.S. Patent 5,522,923 - "Kimura") and further in view of Haning et al. (U.S. Patent 6,042,619 - "Haning").

Given the similarities between these rejections, both rejections are addressed here. The Ogawa reference is similar to the Miyoshi reference in that both references are directed toward TiO₂ coated mica. As such the comments provided above with respect to the rejection of the combination of Miyoshi and Kimura with or without Haning is also applicable here.

As claim 52 was not rejected in the combination of Miyoshi and Kimura with or without Haning, the applicants further state that for this claim the applicants have provided evidence of unexpected results which is not suggested by the combination Ogawa and Kimura with or

without Haning. The thickness of the metal-based layers according to Kimura is between 150 and 500 nm or between 60 and 350 nm.

By comparing Fig. 7 and Fig. 9 in the present application, it is obvious that the thickness of the metal oxide layer according to the invention is essential for effective low transmittance of UV-light (a thickness between 40 and 60 nm being much more efficient than a thickness between 140 and 160 nm for Fe_2O_3 , as is evident from Figs. 7 and 9).

Therefore, for any of the reasons cited above, the combination of Ogawa and Kimura with or without Haning does not establish a holding of *prima facie* obviousness of the applicants' claims.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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